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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/739,448
Filing Date: December 18, 2000
Appellant(s): JOHNSON et al.

Abraham HersHKovitz, Reg. No. 45,294
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 20 August 2010 appealing from the Office
action mailed 5 February 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

1-6, 8-11, 20-39, and 41-55.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

4,567,359 A	Lockwood	01-1986
6,067,522 A	Warady et al.	05-2000
5,523,942 A	Tyler et al.	06-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6, 8-11, 20-39, 41-55 are rejected under 35 U.S.C. §103(a).

These rejections are substantially set forth in prior Office Action, Paper No 20100131 and reproduced hereinbelow. The rejections which appear below substantially repeat the rejections made in the previous Office Action (Paper No 20100131). The text of those sections

of Title 35 U.S. Code relied upon in the Examiner's Answer is set forth in the previous Office action, Paper 20100131.

1. Claims 1-6, 8-11, 20-39, 41-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood, U.S. Patent Number 4, 567, 359 in view of Warady, U.S. Patent Number 6,067,522 and Tyler, U.S. Patent Number 5,523,942.

(A) As per claim 1, Lockwood teaches a method for generating a customized proposal in the development of insurance plans for a customer (Lockwood; column 3, lines 32-44, column 6, lines 3-11), the method comprising:

storing customer data within a database in a computer system (Lockwood; Abstract, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 37 to column 6, line 32, column 7, lines 5-24, column 7, line 43 to column 8, line 15, column 9, lines 13-30) by using one or more modules (Lockwood; Abstract, column 2, lines 48-55); Examiner interprets Lockwood's teachings of "programmed to gather a predetermined sequence of information from a customer on the services in which the customer is interested ... [...] ... transmit the information to the central data processing center ... [...] ... extracts the desired information from its storage ... [...] ... transmits it back to the terminal ... [...] ... relayed to the customer" (Lockwood; column 2, lines 48-55) to teach a form of "using one or more software modules," the database having stored therein insurance plan products with plan requirements data (Lockwood; column 5, lines 37-48); Examiner interprets Lockwood's teaching of "[t]he memory 23 stores program information and information on insurance policies and prices for various insurance companies,

which are periodically up-dated from the terminals 4 of the various companies, and information on policy quotes and sales, which can be accessed periodically by the respective insurance company terminals ... [] ... to perform insurance quotation calculations in response to customer information received from any of the terminals, to send quotation data to the respective terminal” (Lockwood; column 5, lines 37-48) to necessarily include storing in the “memory” (reads on “database”) “insurance plan products with plan requirements data” in order to produce the insurance quotation;

presenting a description of insurance plan options, the options comprising an option currently available to the customer on a “terminal” (reads on “display device of the computer system”) (Lockwood; column 3, lines 9-48, column 6, lines 5-11) based upon the stored customer data and the user selected plan options by using the one or more modules (Lockwood; Abstract, column 2, lines 48-55); Examiner interprets Lockwood’s teachings of “programmed to gather a predetermined sequence of information from a customer on the services in which the customer is interested ... [...] ... transmit the information to the central data processing center ... [...] ... extracts the desired information from its storage ... [...] ... transmits it back to the terminal ... [...] ... relayed to the customer” (Lockwood; column 2, lines 48-55) to teach a form of “presenting a description of insurance plan options currently available to the customer ... [...] ... by using the one or more modules;”

generating a customized proposal in the computer system based upon a selection made from the presented insurance plan options by using the one or more modules, the proposal including a description of a preferred insurance plan (Lockwood; column 2, lines 48-55, column

3, lines 9-48, column 6, lines 17-32), at least a portion of the customer data, and estimated costs for the insurance plan (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

Although Lockwood teaches using one or more modules (Lockwood; column 2, lines 48-55), and “automatically generat[ing] and issue insurance binder agreements according to customer's choice and specifications” (Lockwood; column 1, lines 30-35) and automatically “dispensing information, goods and services such as insurance quotations and policy binders agreements” (Lockwood; column 1, lines 27-30), Lockwood fails to explicitly disclose

determining if a particular insurance plan may be proposed but is not currently configured for the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options by using the one or more modules, the user selected plan options being obtained from an input device of the computer system; and

the description of insurance plan options including an indication that the particular insurance plan being proposed is not currently configured for the customer, and an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan.

However, the above features are well-known in the art, as evidenced by Warady.

In particular, Warady teaches

determining if a particular insurance plan may be proposed but is not currently configured for the customer based upon the stored plan requirements data and either the stored

customer data or user selected plan options by using the one or more modules (Warady; Figure 1, column 4, line 40 to column 5, line 5, column 5, line 65 to column 6, line 7, column 8, lines 20-35, column 9, line 58 to column 10, line 8), the user selected plan options being obtained from an input device of the computer system (Warady; column 13, lines 50-53); and

the description of insurance plan options including an indication that the particular insurance plan being proposed is not currently configured for the customer, and an indication of what “prerequisites” (reads on “conditions”) are not met for the customer to qualify for the proposed but currently not configured insurance plan (Warady; Figure 7b, Figure 8, column 4, line 51 to column 5, line 30, column 5, line 55 to column 6, line 11, column 9, line 58 to column 10, line 8, column 12, line 65 to column 13, line 12); Examiner interprets Warady’s teachings of

“the ... [...] ... system ... [...] ... generates ... [...] ... enrollment form for each employee described in the employee data files 20 and eligible to receive one or more benefits ... [...] ... according to the data and instructions entered into the benefit files 10, the employee data files 20, the sponsor file 30, and the code file 40 in step S1 and are individualized for each employee to include, for example, all benefit plans and coverage options that are available to be selected by the employee [i.e. “not currently configured for the customer”] as well as prices and credits (if any) associated with each benefit plan and coverage option ... [...] ... the information included in each enrollment form can be based, for example, on relevant characteristics of the employee, such as job classification, division, work location, age and salary, and rules established by the employer” (emphasis added) (Warady; column 9, line 58 to column 10, line 8) to teach a form of “including an indication that the particular insurance plan being proposed is not currently configured for the customer;”

and Examiner interprets Warady’s teachings of

“ ... [...] ... prerequisites table 110 stores information describing which benefit plans, if any, described in the benefit tables 100 have prerequisites that must be met before an employee can be enrolled in the plans. For example, certain life insurance plans require evidence of insurability of an employee to be approved by the plan provider before the employee is eligible to receive the chosen ... [...] ... level of coverage. In this example, the prerequisites table 110 could store information describing the conditions under which evidence of insurability is required by the plan provider ... [...] ...” (emphasis added) (Warady; column 5, line 65 to column 6, line 7),

together with Warady’s teachings of

“ ... [...] ... an ‘Underwriters’ Exception Report,’ which is generated periodically ... [...] ... and which lists employees having exceptional circumstances, such as those awaiting evidence of insurability, those on disability, and those whose employment terminated during the period, and an ‘Employee Census Report,’ which is generated on demand and which lists all active employees and information about each needed by certain plan providers for underwriting review and other purposes [i.e. “conditions not yet met for the customer to qualify”] ... [and].... if evidence of insurability or other prerequisites are required to be provided by the employee for approval of a requested benefit, the benefit plan administrator or plan provider notifies the employee” [i.e. provides an indication of conditions not yet met] (emphasis added) (Warady; column 12, line 65 to column 13, line 12),

to teach a form of including “an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan.”

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lockwood to include these limitations, as taught by Warady, with the motivations of enabling enrollment forms that are customized for each employee on an

individual basis, providing a system that manages health and welfare benefit enrollment information, that can communicate the information to interested parties such as, for example, participating employees and plan providers, and produce the billings needed for each plan provider's premiums and/or fees, and reduce time wasted and human error by employers and employees implementing and administering health and welfare benefit plans (Warady, column 1, lines 44-45, 57-61, column 2, lines 35-45).

Lockwood fails to explicitly disclose wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal.

However, the above features are well-known in the art, as evidenced by Tyler.

In particular, Tyler teaches

wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal (Tyler; Abstract, column 4, line 65 to column 5, line 40, column 6, lines 58-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Lockwood and Warady to include these limitations, as taught by Tyler, with the motivations of “design[ing] an insurance product for a customer ... [...] ... receiving a request for information about an insurance product or policy ... [...] ... accessing stored information, such as rates, performing the necessary calculations based on the request and returning the requested information to the user” (Tyler; column 5, lines 32-38) and providing a “uniform approach ... [...] ... in which one user interface can be used to enter

information about all possible products, and where the calculations that are performed are designed based on the operations that take place” (Tyler, column 4, lines 56-62).

(B) As per claims 2-6, Lockwood, Warady, and Tyler teach a method as analyzed and discussed in claim 1 above:

further comprising printing the customized proposal (Lockwood; column 7, lines 5-24);
wherein the generating comprises providing insurance company data as part of the customized proposal (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

further comprising providing the customized proposal in electronic form to the customer (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

wherein the generating comprises deriving the estimated costs from information sorted in the database (Lockwood; column 3, lines 9-48, column 6, lines 17-32); and

further comprising obtaining the user selected plan options from the input device of the computer system (Lockwood; column 3, lines 17-25, column 6, lines 3-4).

(C) As per claim 8, Lockwood, Warady, and Tyler teach a method as analyzed and discussed in claim 1 above wherein the presenting comprises:

selecting, with the input device (Lockwood; column 6, lines 3-4) one or more sets of possible insurance plans from the insurance plan options presented to the customer on the display device (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

determining an estimated cost for each of the selected sets of insurance plans (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30); and

generating a customized comparison for the possible set of insurance plans in the sales computer system that includes the customer data, the description of the selected insurance plans, and the estimated costs for the selected set of insurance plans (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

(D) As per claims 9-10, Lockwood, Warady, and Tyler teach a method as analyzed and discussed in claim 1 above

wherein the available insurance plan options comprise a plurality of health insurance plans (Lockwood; column 3, lines 32-36);

further comprising transmitting the customer data and the user selected plan options from the computer system to a remote server system for processing of a request for insurance (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

(E) Claim 11 differs from method claim 1 by reciting a “computer program product readable by a computer system ...” in the preamble. As per this limitation, Lockwood clearly discloses his invention to be implemented on a computer program product readable by a computer system ... (Lockwood; Figure 1, column 2, lines 8-18, 34-46). The remainder of claim 11 substantially repeats the limitations of claim 1, and is therefore rejected for the same reasons given above for claim 1.

The motivations for combining the respective teachings of Lockwood, Warady, and Tyler are as given in the rejection of claim 1 above, and incorporated herein.

(F) As per claims 20-23, Lockwood, Warady, and Tyler teach a method as analyzed and discussed in claim 1 above

wherein the generating comprises providing an insurance plan as part of the customized proposal (Lockwood; column 3, lines 9-48, column 6, lines 17-32);

wherein the generating comprises gathering “predetermined customer information” (reads on providing insurance application forms”) as part of the customized proposal (Lockwood; column 3, lines 15-16);

wherein the generating comprises providing “a series of quotations from various institutions... purchaser can compare quotations” (reads on “benefit charts data”) as part of the customized proposal. (Lockwood; column 3, lines 32-33); and

wherein the generating comprises providing provider information data as part of the customized proposal (Lockwood; column 7, lines 5-12).

(G) As per claims 24-27, Lockwood, Warady, and Tyler teach a method as analyzed and discussed in claim 1 above, wherein the available insurance plan options comprise

a plurality of dental insurance plans (Warady; column 4, lines 1-19);

a plurality of life insurance plans (Warady; column 4, lines 1-19);

a plurality of disability insurance plans (Warady; column 4, lines 1-19); and

wherein the insurance plan comprises a set of insurance plans (Warady; column 4, lines 1-19).

The motivations for combining the respective teachings of Lockwood, Warady, and Tyler are as given in the rejection of claim 1 above, and incorporated herein.

(H) As per claims 28-29, Lockwood, Warady, and Tyler teach a method as analyzed and discussed in claim 1 above

wherein the storing comprises storing the customer data and insurance plan products in a relational database (Tyler; Figure 6C, column 22, lines 37-38) that is hosted in a networked environment (Lockwood; column 2, lines 34-46) with portions stored in a remote memory storage device (Lockwood; column 2, lines 51-54); and

wherein the storing comprises storing the customer data and insurance plan products in a relational database (Tyler; Figure 6C, column 22, lines 37-38) comprising a plurality of modules (Warady; Figure 1, column 8, lines 20-35).

The motivations for combining the respective teachings of Lockwood, Warady, and Tyler are as given in the rejection of claim 1 above, and incorporated herein.

(I) Claim 30 differs from method claim 1, in that it is a system rather than a method for generating a customized proposal in the development of insurance plans for a customer.

System claims 30-39, 41-47 repeat the subject matter of claims 1-3, 20-23, 4-6, 8-9, 24-26, 10, and 27 respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 1-3, 20-23, 4-6, 8-9, 24-26, 10, and 27 have been shown to be fully disclosed or obvious by the collective teachings of Lockwood, Warady, and Tyler in the above rejection of claims 1-3, 20-23, 4-6, 8-9, 24-26, 10, and 27, it is readily apparent that the system disclosed collectively by Lockwood, Warady, and Tyler includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1-3, 20-23, 4-6, 8-9, 24-26, 10, and 27, and incorporated herein. As per the recitation in claim 39 of “the input device processor unit is configured to prompt the user to input selected plan options,” Examiner interprets Lockwood’s teachings of “[t]he presentation solicits and allows the customer to enter information at various points via the touch pad 13 displayed on the monitor screen” (Lockwood; column 5, lines 7-9, column 6, lines 2-13) to teach a form of this limitation.

(J) Claims 48-49 differ from method claims 28-29 in that they recite a system rather than a method for generating a customized proposal in the development of insurance plans for a customer.

System claims 48-49 repeat the subject matter of claims 28-29 respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 28-29 have been shown to be fully disclosed or obvious by the collective teachings of Lockwood, Warady, and Tyler in the above rejection of claims 28-29, it is readily apparent that the system disclosed collectively by Lockwood, Warady, and Tyler includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 28-29, and incorporated herein.

(K) As per claim 50, Lockwood, Warady, and Tyler teach a method for generating a customized proposal in the development of insurance plans for a customer (Lockwood; column 3, lines 32-44, column 6, lines 3-11), the method comprising:

storing customer data within a database in a computer system (Lockwood; Abstract, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 37 to column 6, line 32, column 7, lines 5-24, column 7, line 43 to column 8, line 15, column 9, lines 13-30) by using one or more modules (Lockwood; Abstract, column 2, lines 48-55); Examiner interprets Lockwood's teachings of "programmed to gather a predetermined sequence of information from a customer on the services in which the customer is interested ... [...] ... transmit the information to the central data processing center ... [...] ... extracts the desired information from its storage ... [...] ... transmits it back to the terminal ... [...] ... relayed to the customer" (Lockwood;

column 2, lines 48-55) to teach a form of using one or more software modules, the database having stored therein insurance plan products with plan requirements data (Lockwood; column 5, lines 37-48); Examiner interprets Lockwood's teaching of "[t]he memory 23 stores program information and information on insurance policies and prices for various insurance companies, which are periodically up-dated from the terminals 4 of the various companies, and information on policy quotes and sales, which can be accessed periodically by the respective insurance company terminals ... [] ... to perform insurance quotation calculations in response to customer information received from any of the terminals, to send quotation data to the respective terminal" (Lockwood; column 5, lines 37-48) to necessarily include storing in the "memory" (reads on "database") plan requirements data in order to produce the insurance quotation;

comparing in the computer system the customer data with the plan requirements data from the stored insurance plan products by using the one or more modules (Warady; column 5, line 65 to column 6, line 23, column 8, lines 20-46, column 10, lines 55-67); Examiner interprets Warady's teaching of "... [...] ... system 1 generates a confirmation of each employee's enrollment status ... [...] ... " (Warady; column 10, lines 55-57) together with Warady's teachings of "an 'Underwriters' Exception Report,' which is generated periodically ... [...] ... and which lists employees having exceptional circumstances, such as those awaiting evidence of insurability, those on disability, and those whose employment terminated during the period, and an "Employee Census Report," which is generated on demand and which lists all active employees and information about each needed by certain plan providers for underwriting review and other purposes"(Warady; column 12, line 66 to column 13, line 8) to teach a form of

“comparing the customer data with the plan requirements data from the stored insurance plan products by using the one or more modules;”

determining if a particular insurance plan may be proposed but is not currently configured for the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options by using the one or more modules (Warady; Figure 1, column 4, line 51 to column 5, line 5, column 5, line 65 to column 6, line 7, column 8, lines 20-35, column 9, line 58 to column 10, line 8), the user selected plan options being obtained from an input device of the computer system (Warady; column 13, lines 50-53); and

presenting a description of insurance plan options, the options comprising an option currently available to the customer on a “terminal” (reads on “display device of the computer system”) (Lockwood; column 3, lines 9-48, column 6, lines 5-11) based upon the stored customer data and the user selected plan options by using the one or more modules (Lockwood; Abstract, column 2, lines 48-55); Examiner interprets Lockwood’s teachings of “programmed to gather a predetermined sequence of information from a customer on the services in which the customer is interested ... [...] ... transmit the information to the central data processing center ... [...] ... extracts the desired information from its storage ... [...] ... transmits it back to the terminal ... [...] ... relayed to the customer” (Lockwood; column 2, lines 48-55) to teach a form of “presenting a description of insurance plan options, the options comprising an option currently available to the customer ... [...] ... by using the one or more modules,” the description of insurance plan options including an indication that the particular insurance plan being proposed is not currently configured for the customer, and an indication of what “prerequisites” (reads on

“conditions”) are not met for the customer to qualify for the proposed but currently not configured insurance plan (Warady; Figure 7b, Figure 8, column 4, line 51 to column 5, line 30, column 5, line 55 to column 6, line 11, column 9, line 58 to column 10, line 8, column 12, line 65 to column 13, line 12); Examiner interprets Warady’s teachings of

“the ... [...] ... system ... [...] ... generates ... [...] ... enrollment form for each employee described in the employee data files 20 and eligible to receive one or more benefits ... [...] ... according to the data and instructions entered into the benefit files 10, the employee data files 20, the sponsor file 30, and the code file 40 in step S1 and are individualized for each employee to include, for example, all benefit plans and coverage options that are available to be selected by the employee [i.e. “not currently configured for the customer”] as well as prices and credits (if any) associated with each benefit plan and coverage option ... [...] ... the information included in each enrollment form can be based, for example, on relevant characteristics of the employee, such as job classification, division, work location, age and salary, and rules established by the employer” (emphasis added) (Warady; column 9, line 58 to column 10, line 8) to teach a form of “including an indication that the particular insurance plan being proposed is not currently configured for the customer;”

and Examiner interprets Warady’s teachings of

“ ... [...] ... prerequisites table 110 stores information describing which benefit plans, if any, described in the benefit tables 100 have prerequisites that must be met before an employee can be enrolled in the plans. For example, certain life insurance plans require evidence of insurability of an employee to be approved by the plan provider before the employee is eligible to receive the chosen ... [...] ... level of coverage. In this example, the prerequisites table 110 could store information describing the conditions under which evidence of insurability is required by the plan provider ... [...] ...” (emphasis added) (Warady; column 5, line 65 to column 6, line 7),

together with Warady's teachings of

“ ... [...] ... an ‘Underwriters' Exception Report,’ which is generated periodically ... [...] ... and which lists employees having exceptional circumstances, such as those awaiting evidence of insurability, those on disability, and those whose employment terminated during the period, and an ‘Employee Census Report,’ which is generated on demand and which lists all active employees and information about each needed by certain plan providers for underwriting review and other purposes [i.e. “conditions not yet met for the customer to qualify”] ... [and].... if evidence of insurability or other prerequisites are required to be provided by the employee for approval of a requested benefit, the benefit plan administrator or plan provider notifies the employee” [i.e. provides an indication of conditions not yet met] (emphasis added) (Warady; column 12, line 65 to column 13, line 12), to teach a form of including “an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan;” and generating a customized proposal in the computer system that is “extracted” from stored information (reads on “different from the stored insurance products”) (Lockwood; column 2, lines 47-60) by the comparing the customer data and the determining of the particular insurance plan, based upon a selection made from the presented insurance plan options by using the one or more modules, the proposal including a description of a preferred insurance plan by using the one or more modules (Lockwood; column 2, lines 48-55), at least a portion of the customer data, and estimated costs for the preferred insurance plan (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal (Tyler; Abstract, column 4, line 65 to column 5, line 40, column 6, lines 58-65).

The motivations for combining the respective teachings of Lockwood, Warady, and Tyler are as given in the rejection of claim 1 above, and incorporated herein.

(L) Claim 51 differs from method claim 50 by reciting a “computer program product readable by a computer system ...” in the preamble. As per this limitation, Lockwood clearly discloses his invention to be implemented on a computer program product readable by a computer system ... (Lockwood; Figure 1, column 2, lines 8-18, 34-46). The remainder of claim 51 repeats the limitations of claim 50, and is therefore rejected for the same reasons given above for claim 50.

The motivations for combining the respective teachings of Lockwood, Warady, and Tyler are as given in the rejection of claim 1 above, and incorporated herein.

(M) Claim 52 differs from method claim 50, in that it is a system rather than a method for generating a customized proposal in the development of insurance plans for a customer.

System claim 52 repeats the subject matter of claim 50, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 50 have been shown to be fully disclosed or obvious by the collective teachings of Lockwood, Warady, and Tyler in the above rejection of claim 50, it is readily apparent that the system disclosed collectively by

Lockwood, Warady, and Tyler includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 50, and incorporated herein. . As per the recitation in claim 52 of “an input device configured to prompt a user of the computer system to input customer data ... [...] ...,” Examiner interprets Lockwood’s teachings of “[t]he presentation solicits and allows the customer to enter information at various points via the touch pad 13 displayed on the monitor screen” (Lockwood; column 5, lines 7-9, column 6, lines 2-13) to teach a form of this limitation.

(N) As per claims 53-54, Lockwood, Warady, and Tyler teach a method as analyzed and discussed in claim 1 above further comprising:

tracking the status of proposals (Lockwood; column 5, lines 36-55, column 6, lines 7-9, column 7, line 60 to column 8, line 2);

storing and printing sales collateral material and forms (Lockwood; Abstract, column 1, lines 45-55, column 6, lines 10-11); and

“dispensing information and contractual services to the general public” (reads on “providing a product discovery consultation function” (Lockwood; column 1, lines 23-36);

wherein the computer system that is used in the storing of the customer data, is a component based, object-oriented design that is distributed across a multi-tier architecture, the multi-tier architecture comprising a standard networking communications interface (reads on “an application layer, a presentation layer, a session layer and a data layer”) (Tyler; Figure 1B,

column 5, lines 32-40, column 6, lines 10-13, 46-57, column 9, lines 19-35, column 10, line 48 to column 11, line 31).

The motivations for combining the respective teachings of Lockwood, Warady, and Tyler are as given in the rejection of claim 1 above, and incorporated herein.

(O) As per claim 55, Lockwood, Warady, and Tyler teach a method for generating a customized proposal in the development of insurance plans for a customer, the method comprising:

storing customer data within a database in a computer system (Lockwood; Abstract, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 37 to column 6, line 32, column 7, lines 5-24, column 7, line 43 to column 8, line 15, column 9, lines 13-30) by using one or more modules (Lockwood; Abstract, column 2, lines 48-55); Examiner interprets Lockwood's teachings of "programmed to gather a predetermined sequence of information from a customer on the services in which the customer is interested ... [...] ... transmit the information to the central data processing center ... [...] ... extracts the desired information from its storage ... [...] ... transmits it back to the terminal ... [...] ... relayed to the customer" (Lockwood; column 2, lines 48-55) to teach a form of "using one or more software modules," the database having stored therein insurance plan products with plan requirements data (Lockwood; column 5, lines 37-48); Examiner interprets Lockwood's teaching of "[t]he memory 23 stores program information and information on insurance policies and prices for various insurance companies, which are periodically up-dated from the terminals 4 of the various companies, and information

on policy quotes and sales, which can be accessed periodically by the respective insurance company terminals ... [] ... to perform insurance quotation calculations in response to customer information received from any of the terminals, to send quotation data to the respective terminal” (Lockwood; column 5, lines 37-48) to necessarily include storing in the “memory” (reads on “database”) plan requirements data in order to produce the insurance quotation;

determining if a particular insurance plan may be proposed but is not currently configured for the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options by using the one or more modules (Warady; Figure 1, column 4, line 51 to column 5, line 5, column 5, line 65 to column 6, line 11, column 8, lines 20-35, column 9, line 58 to column 10, line 8), the user selected plan options being obtained from an input device of the computer system (Warady; column 13, lines 50-53);

presenting a description of insurance plan options (Lockwood; column 3, lines 9-48, column 6, lines 5-11), the options comprising an option currently available to the customer on a “terminal” (reads on “display device of the computer system”) (Lockwood; column 3, lines 9-48, column 6, lines 5-11) based upon the stored customer data and the user selected plan options by using the one or more modules (Lockwood; Abstract, column 2, lines 48-55); Examiner interprets Lockwood’s teachings of “programmed to gather a predetermined sequence of information from a customer on the services in which the customer is interested ... [...] ... transmit the information to the central data processing center ... [...] ... extracts the desired information from its storage ... [...] ... transmits it back to the terminal ... [...] ... relayed to the customer” (Lockwood; column 2, lines 48-55) to teach a form of “presenting a description of

insurance plan options currently available to the customer ... [...] ... by using the one or more modules;” the description of insurance plan options including an indication that the particular insurance plan being proposed is not currently configured for the customer, and an indication of what “prerequisites” (reads on “conditions”) are not met for the customer to qualify for the proposed but currently not configured insurance plan (Warady; Figure 7b, Figure 8, column 4, line 51 to column 5, line 30, column 5, line 55 to column 6, line 11, column 9, line 58 to column 10, line 8, column 12, line 65 to column 13, line 12); Examiner interprets Warady’s teachings of

“the ... [...] ... system ... [...] ... generates ... [...] ... enrollment form for each employee described in the employee data files 20 and eligible to receive one or more benefits ... [...] ... according to the data and instructions entered into the benefit files 10, the employee data files 20, the sponsor file 30, and the code file 40 in step S1 and are individualized for each employee to include, for example, all benefit plans and coverage options that are available to be selected by the employee [i.e. “not currently configured for the customer”] as well as prices and credits (if any) associated with each benefit plan and coverage option ... [...] ... the information included in each enrollment form can be based, for example, on relevant characteristics of the employee, such as job classification, division, work location, age and salary, and rules established by the employer” (emphasis added) (Warady; column 9, line 58 to column 10, line 8) to teach a form of “including an indication that the particular insurance plan being proposed is not currently configured for the customer;”

and Examiner interprets Warady’s teachings of

“ ... [...] ... prerequisites table 110 stores information describing which benefit plans, if any, described in the benefit tables 100 have prerequisites that must be met before an employee can be enrolled in the plans. For example, certain life insurance plans require evidence of insurability of an employee to be approved by the plan provider before the employee is eligible to receive the chosen ... [...] ... level of coverage. In this

example, the prerequisites table 110 could store information describing the conditions under which evidence of insurability is required by the plan provider ... [...] ...” (emphasis added) (Warady; column 5, line 65 to column 6, line 7),

together with Warady’s teachings of

“ ... [...] ... an ‘Underwriters’ Exception Report,’ which is generated periodically ... [...] ... and which lists employees having exceptional circumstances, such as those awaiting evidence of insurability, those on disability, and those whose employment terminated during the period, and an ‘Employee Census Report,’ which is generated on demand and which lists all active employees and information about each needed by certain plan providers for underwriting review and other purposes [i.e. “conditions not yet met for the customer to qualify”] ... [and].... if evidence of insurability or other prerequisites are required to be provided by the employee for approval of a requested benefit, the benefit plan administrator or plan provider notifies the employee” [i.e. provides an indication of conditions not yet met] (emphasis added) (Warady; column 12, line 65 to column 13, line 12), to teach a form of including “an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan;” and generating a customized proposal in the computer system based upon a selection made from the presented insurance plan options by using the one or more modules, the proposal including a description of a preferred insurance plan, at least a portion of the customer data, and estimated costs for the preferred insurance plan (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30), (Warady; Figure 8, column 9, line 59 to column 10, line 21, column 10, lines 55-67, column 11, lines 32-35),

wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal (Tyler; Abstract, column 4, line 65 to column 5, line 40, column 6, lines 58-65), and

wherein the insurance plans comprise at least one of health insurance plans, life insurance plans, disability insurance plans, auto insurance plans, or employee insurance benefit plans (Warady; column 4, lines 1-9).

The motivations for combining the respective teachings of Lockwood, Warady and Tyler are as given in the rejection of claim 1 above, and incorporated herein.

(10) Response to Argument

In the Appeal Brief filed 20 August 2010, Appellant makes the following argument:

Arguments for Patentability

(A) All claims rejected under 35 U.S.C. §103(a) over Lockwood in view of Warady and further in view of Tyler

(B) Independent claims 1, 11, 30, 50-52, and 55 are patentable over the combination of Lockwood and Warady and Tyler

1. TWO DISTINCT INDICATIONS ARE REQUIRED

2. NO PRIMA FACIE REJECTION OF “DETERMINING” FEATURE

(C) Independent claims 50-52 are not obvious over the combination of Lockwood and Warady and Tyler

1. LOCKWOOD DOES NOT TEACH "GENERATING"
2. WARADY DOES NOT TEACH "GENERATING"

(D) Dependent claims 2-6, 8-29, 30-39, 41-49, 53 and 54

(E) Conclusion

Examiner will address Appellant's arguments in sequence as they appear in the brief.

(A) All claims rejected under 35 U.S.C. §103(a) over Lockwood in view of Warady and further in view of Tyler

There is no specific argument under this heading, which discusses the applicable law; the subject matter is discussed below.

(B) Independent claims 1, 11, 30, 50-52, and 55 are patentable over the combination of Lockwood and Warady and Tyler

1. TWO DISTINCT INDICATIONS ARE REQUIRED

At pages 17-20 of the Appeal Brief filed 20 August 2010, Appellant argues that “two indications” are required by the independent claims, and that the applied references fail to teach “two indications.” Examiner respectfully disagrees.

Following is the summary table showing the argued limitations and the applied reference citations.

Claims	Argued Limitations	References	
		Citation	Relevant Quotations
Claims 1, 11, 30, 50-52, 55	<p><i>First Indication:</i></p> <p>“an indication that the particular insurance plan being proposed is not currently configured for the customer”</p>	Warady; column 9, line 58 to column 10, line 8	<p>“the ... [...] ... <u>system</u> ... [...] ... generates ... [...] ... enrollment form <u>for each employee described in the employee data files 20 and eligible to receive one or more benefits ... [...] ... according to the data and instructions entered into the benefit files 10, the employee data files 20, the sponsor file 30, and the code file 40 in step S1 and are <u>individualized</u> for each employee to include, for example, <u>all benefit plans and coverage options that are available to be selected by the employee</u> [i.e. “not currently configured for the customer”] as well as prices and credits (if any) associated with each benefit plan and coverage option ... [...] ... the information included in each enrollment form <u>can be based</u> [i.e. “not currently configured for the customer”], for example, on relevant characteristics of the employee, such as job classification, division, work</u></p>

			location, age and salary, and rules established by the employer” (emphasis added)
Claims	Argued Limitations	References	
		Citation	Relevant Quotations
Claims 1, 11, 30, 50-52, 55	<i>Second Indication:</i> “an indication of what conditions are not met for the customer to qualify for the proposed but currently not configured insurance plan”	Warady; column 5, line 65 to column 6, line 7	“... [...] ... prerequisites table 110 stores information describing which benefit plans, if any, described in the benefit tables 100 have <u>prerequisites that must be met before an employee can be enrolled</u> in the plans. For example, certain life insurance plans require <u>evidence of insurability</u> of an employee to be approved by the plan provider <u>before the employee is eligible</u> to receive the chosen ... [...] ... level of coverage. In this example, the prerequisites table 110 could store information describing the <u>conditions under which evidence of insurability</u> is required by the plan provider ... [...] ...” (emphasis added)
		Warady; column 12, line 65 to column 13, line 12	“ ... [...] ... an ‘Underwriters’ Exception Report,’ which is generated periodically ... [...] ... and which lists employees having exceptional circumstances, such as those awaiting evidence of insurability, those on disability, and those whose employment terminated during the period, and an ‘Employee Census Report,’ which is generated on demand and which lists all active employees and <u>information about each needed</u> by certain plan providers for underwriting review and other purposes [i.e. “conditions not

			yet met for the customer to qualify”] ... [and].... if evidence of insurability or other prerequisites are required to be provided by the employee for approval of a requested benefit, the benefit plan administrator or plan provider <u>notifies the employee</u> [i.e. provides an indication of conditions not yet met]” (emphasis added)
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Accordingly, Examiner submits that both claimed indications are taught by the applied references. Moreover, Examiner notes that Appellant’s specification is imprecise as to further defining the claimed two indications.

2. *NO PRIMA FACIE REJECTION OF “DETERMINING” FEATURE*

At page 20 of the Appeal Brief filed 20 August 2010, Appellant argues that Examiner has erred and that the applied references fail to teach the “determining” step. Examiner respectfully disagrees.

Following is the summary table showing the argued limitations and the applied reference citations.

Claims	Argued Limitations	References	
		Citation	Relevant Quotations
Claims 1, 11, 30, 50-52, 55	“determining if a particular insurance plan may be proposed but is not currently configured for the customer based on ... [...] ...”	Warady; column 9, line 58 to column 10, line 8	“the ... [...] ... <u>system</u> ... [...] ... generates ... [...] ... enrollment form <u>for each employee described in the employee data files 20 and eligible to receive one or more benefits ... [...] ... according to the data and instructions entered into the benefit files 10, the employee data files 20, the sponsor file 30, and the code file 40 in step S1 and are individualized for each employee to include, for example, all benefit plans and coverage options that are available to be selected by the employee</u> [i.e. “proposed but not currently configured for the customer”] as well as prices and credits (if any) associated with each benefit plan and coverage option ... [...] ... the information included in each enrollment form <u>can be based</u> [i.e. “proposed but not currently configured for the customer”], for example, on relevant characteristics of the employee, such as job classification, division, work location, age and salary, and rules established by the employer” (emphasis added)
		Warady; column 12, line 65 to column 13, line 12	“ ... [...] ... an ‘Underwriters’ Exception Report,’ which is generated periodically ... [...] ... and which lists employees having exceptional circumstances, such as those awaiting evidence of insurability, those on disability, and those whose employment terminated during the period, and an ‘Employee Census Report,’ which is generated on demand and which lists all active employees and <u>information about each needed</u> by certain plan providers for underwriting review and other purposes [i.e. “proposed but not currently configured for the customer as conditions are not yet met for the customer to qualify”] ... [and].... if evidence of insurability or other prerequisites are required to be provided by the employee for approval of a requested benefit, the benefit plan administrator or

			plan provider notifies the employee” (emphasis added)
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Accordingly, Examiner submits that the “determining” limitations are taught by the applied references. Moreover, Examiner observes that Appellant’s specification is imprecise as to further defining the “determining” step.

(C) Independent claims 50-52 are not obvious over the combination of Lockwood and Warady and Tyler

There is no specific argument under this heading, which recites claim limitations; the subject matter is discussed below.

1. LOCKWOOD DOES NOT TEACH “GENERATING”

At pages 21-22 of the Appeal Brief filed 20 August 2010, Appellant argues that the applied references fail to teach the “generating” limitations recited in claims 50-52. Examiner respectfully disagrees.

Examiner interprets Lockwood’s teachings of “[t]he system as applied to the insurance industry is arranged to give personalized insurance quotations, make sales and take orders,” (emphasis added) (Lockwood; column 3, lines 40-42) together with Lockwood’s detailed “sequence of operations” (Lockwood; column 5, line 65 to column 6, line 32) resulting in a customized proposal to purchase insurance (see steps (1)-(8)) together with Lockwood’s

teachings of “[e]ach sales and information terminal is programmed to gather a predetermined sequence of information from a customer on the services in which the customer is interested [“comparing the customer data”], and to transmit the information to the central data processing center. In response to the gathered information, the central data processing center extracts the desired information from its storage and transmits it back to the terminal where it is relayed to the customer ... [...] Subsequently, the terminal is programmed to accept an order for the offered services from the customer, to collect payment and to dispense the services to the customer” (Lockwood; column 2, lines 47-59) to teach a form of “generating a customized proposal in the computer system that is different from the stored insurance products by the comparing the customer data,” [i.e. as a result of comparing the customer data, it is only an extracted subset of the stored information, and therefore different from the stored information that is used to present the customer with the personalized insurance product information].

Moreover, Examiner notes that the Warady reference teaches “[t]he data entry and user interface module 50 enables a user of the health and welfare benefit enrollment and billing system 1 to enter, review, extract, and modify the data stored in the various files of the health and welfare benefit enrollment and billing system” (emphasis added) (Warady; column 8, lines 26-30), and the Warady reference teaches “the information included ... can be based, for example on relevant characteristics of the employee, such as job classification, division, work location, age, and salary ...” (Warady; column 10, lines 1-6), which Examiner interprets to teach a form of “generating a customized proposal in the computer system that is different from the stored insurance products by the comparing the customer data ...”.

As such, it is unclear as to how or why Applicant's claimed limitations are not met by at least the aforementioned passages.

2. WARADY DOES NOT TEACH "GENERATING"

With respect to Appellant's arguments in this section, these have been addressed earlier in this Examiner's Answer.

Examiner notes that at sections "(C) 1." and "(C) 2." above Appellant analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re*

Conrad 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

As such,, it is respectfully submitted that Appellant appears to view the applied references separately, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

(D) Dependent claims 2-6, 8-29, 30-39, 41-49, 53 and 54

Examiner respectfully notes that the dependent claims listed above in heading “(D)” include both canceled claims and independent claims. Examiner notes that the dependent claims, as correctly displayed on page 3 of the Appeal Brief, should include only claims 2-6, 8-10, 20-29, 30-39, 41-49, 53 and 54.

There is no specific argument under this heading.

(E) Conclusion

There is no specific argument under this heading.

Conclusion

Appellant’s arguments at pages 17-24 of the Appeal brief submitted 20 August 2010 do not appear to persuasively require a withdrawal of the Examiner’s grounds of rejection. As specified in the remarks and rebuttals given above, Appellant’s arguments apparently fail to appreciate the clear and unmistakable suggestions provided in the prior art of record, and relied

upon by the Examiner for motivation to combine such well-known elements of the prior art. As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the present Examiner's Answer as well as the previous Office Action (Paper Number 20100131), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Thus, in light of the reasons and responses given above, it is respectfully submitted that a *prima facie* case of obviousness has been clearly established by the Examiner.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Examiner, Art Unit 3686
/N. A. P./
October 21, 2010

/Gerald J. O'Connor/
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